REMARKS

In response to the Office Action dated April 16, 2010, Applicant has amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicant reserves the right to prosecute the same or similar subject matter in this or another application.

Claims 1-21 and 33-35 are pending in this application. By this Amendment, Claim 1 has been amended and Claims 33-35 have been canceled. Support for the amendments can be found starting on page 16, line 16 through page 18, line 2. Applicant respectfully submits that no new matter has been added to the subject application by this amendment. Moreover, it is submitted that the claims as now presented place the subject application in condition for immediate allowance.

The Examiner has rejected Claims 1-3, 5-9, 11-14, 17-21 and 33-35 under 35 U.S.C. §103(a) as being unpatentable over Francisco et al. U.S. Patent No. 5,308,522 ("Francisco et al.") in view of Kolosov et al. U.S. Patent Application No. 2004/0123650 ("Kolosov et al."). Of these claims, Claim 1 has been amended and Claims 33-35 have been canceled.

Francisco et al. disclose a lubricant composition containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further disclose in Example 3 testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and

tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. The percent swell and percent change in tensile strength are calculated from these measurements and reported in Table 2 therein.

In contrast to the presently claimed invention, Francisco et al. fail to disclose or suggest a "high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) conducting molecular modeling of at least one base oil of lubricating viscosity and at least one lubricating oil additive to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing; (b) containing a plurality of the leading candidate lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive in varying percentages in a plurality of test receptacles; (c) providing at least one elastomer; (d) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (e) outputting the results of step (d)", as presently recited in amended Claim 1.

Francisco et al. however is completely silent as to the presently recited step of molecular modeling to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing in the claimed method. Thus, Francisco et al. cannot provide any suggestion or motivation to create a high throughput method for screening a plurality of different lubricating oil composition samples for compatibility with elastomers of each sample employing the specifically recited steps (a)-(e).

Kolosov et al. do not cure the deficiencies of Francisco et al. Rather, Kolosov et al. disclose a high throughout method and system used to screen or test most any flowable material that may be a commercial product itself or may be an ingredient or portion within a commercial product. Kolosov et al. further disclose that the invention thus has particular utility in connection with the screening of a number of different material forms including, for example, gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, emulsions or the like. Kolosov et al., as with Francisco et al., is likewise silent as to the presently recited step of molecular modeling to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing in the claimed method. Thus, even by combining Francisco et al. with Kolosov et al., one skilled in the art would not arrive at the claimed invention.

Accordingly, amended Claims 1-3, 5-9, 11-14, and 17-21 are believed to be nonobvious, and therefore patentable, over Francisco et al. and Kolosov et al., no matter how these references are considered or combined. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Francisco et al. in view of Kolosov et al. and further in view of Chaffee et al. U.S. Patent No. 4,774,281 ("Chaffee et al.").

The deficiencies of Francisco et al. and Kolosov et al. discussed above with respect to the rejection of Claim 1, from which Claims 15 and 16 ultimately depend, apply with equal force to this rejection. Chaffee et al. do not cure and are not cited as curing the deficiencies of Francisco et al. and Kolosov et al. Rather, Chaffee et al. are cited for the disclosure of thermally conditioning of the elastomer. Chaffee et al., as with Francisco et al. and Kolosov et al., is likewise silent as to the presently recited step of molecular modeling to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing in the claimed method. Thus, even by combining Francisco et al. with Kolosov et al. and Chaffee et al., one skilled in the art would not arrive at the claimed invention.

Accordingly, Claims 15 and 16 are believed to be nonobvious, and therefore patentable, over Francisco et al., Kolosov et al. and Chaffee et al., no matter how these references are considered or combined. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 4 and 10 under 35 U.S.C. §103(a) as being unpatentable over Francisco et al. in view of Kolosov et al. and further in view of Chaffee et al. taken in view of Migdal et al. U.S. Patent No. 5,062,980 ("Migdal et al.").

The deficiencies of Francisco et al., Kolosov et al. and Chafee et al. discussed above apply with equal force to this rejection. Migdal et al. do not cure and are not cited as curing the deficiencies of Francisco et al., Kolosov et al. and Chaffee et al. Rather, Migdal et al. are cited for the disclosure of polysuccinimide compositions as dispersants for lubricating motor oils, which have greater compatability with synthetic rubbers such as Viton engine seals. Migdal et al., as with Francisco et al., Kolosov et al. and Chaffee et al., are silent as to the presently recited

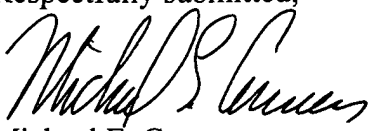
step of molecular modeling to provide leading candidates of the at least one base oil of lubricating viscosity and the at least one lubricating oil additive for combination to formulate a leading candidate lubricating oil composition sample for testing in the claimed method. Thus, even by combining Francisco et al. with Kolosov et al., Chaffee et al. and Migdal et al., one skilled in the art would not arrive at the claimed invention.

Accordingly, Claims 4 and 10 are believed to be nonobvious, and therefore patentable, over Francisco et al., Kolosov et al., Chaffee et al. and Migdal et al., no matter how these references are considered or combined. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 1-3 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al. and further in view of Bailey et al. U.S. Patent No. 3,108,397. Applicant submits herewith a Terminal Disclaimer disclaiming that part of the term of any patent maturing from this application, which would extend beyond the term of the patent of U.S. Patent No. 7,137,289, thus overcoming the judicially created doctrine of obviousness-type double patenting provisional rejection. Accordingly, withdrawal of the rejection is respectfully requested.

For the foregoing reasons, Claims 1-21 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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